

REMARKS

Claim Objections and Rejections

Claims 12 and 13 are rejected under 35 U.S.C. § 112, first and second paragraphs. Claims 13 is rejected under 35 U.S.C. § 102(e) as being anticipated by Howard et al. (U.S. 2002/0069365). Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Howard et al. in view of Candelore (U.S. 6,697,489). Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Howard et al.

The Examiner has also objected to the terms “series number,” “downloading,” and “uploading.” In response, Applicant has corrected these errors.

Drawings

Applicant proposes to amend Figures 2-5, as illustrated in red on the attached photocopies. In Figure 2 it is proposed to label arrow 22 as “The Data is Transferred.” In Figures 3-5 it is proposed to correct the typographical errors regarding “servo,” “series,” and “the decrypt is transferred,” as noted by the Examiner. No “new matter” has been added to the original disclosure by the proposed amendments to these figures. It is believed the foregoing proposed amendments obviate the outstanding objections to the drawings. Approval of the proposed drawing changes is respectfully requested.

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, except for the above proposed drawing corrections, Applicant must assume that the drawings are acceptable as filed.

Substitute Specification

It was felt that the most expeditious way of correcting the numerous grammatical and idiomatic inaccuracies present in the specification as filed was the preparation of a Substitute Specification. Applicant has not added a CROSS REFERENCE TO RELATED APPLICATIONS in connection with this matter because although an application data sheet has not been filed, the Declaration clearly claims benefit of the priority application and it is not believed that the priority

application needs to be addressed in this section. Applicant has corrected the numerous grammatical and idiomatic inaccuracies noted by the Examiner including clarifying that the user receives the encrypted data by downloading it to an access device (e.g., a mobile phone or PDA). It is believed that the Substitute Specification overcomes the outstanding objections to the specification. The Substitute Specification is attached hereto and is accompanied by a marked-up copy of the original specification which indicates the changes made thereto by the Substitute Specification. No “new matter” has been added to the original disclosure by the Substitute Specification. Entry of the Substitute Specification is respectfully requested.

Abstract of the Disclosure

Applicant is submitting a substitute Abstract of the Disclosure for that originally filed with this application to more clearly describe the claimed invention. Entry of the Substitute Abstract of the Disclosure is respectfully requested.

Claim Amendments

By this Amendment, Applicant has amended claims 12 and 13, as well as the specification, of this application to obviate the outstanding rejections under 35 U.S.C. 112. With regard to the Examiner's rejections under 35 U.S.C. 112, first paragraph, Applicant has amended the specification to clarify that the user receives the encrypted data by downloading it to an access device (e.g., a mobile phone or PDA). In addition, Applicant has amended claims 12 and 13 to recite the step of “e) preventing users not connected to the access device having the series number from *playing* the encrypted data” (*Emphasis added*) and submits that paragraphs [19]-[20] of the specification provides support for this amendment.

In view of the above, it is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The amended claim 12 is directed toward a method for safely encrypting transmission data including, *inter alia*, the step of preventing users not connected to the access device having the serial number from playing the encrypted data, in which in the encrypting step the data is an music data and ***the access device is a personal digital assistant (PDA) or mobile phone*** having an MP3 playing function for playing the music data. The amended claim 13 is directed toward a method for safely encrypting transmission data including, *inter alia*, the step of preventing users not connected to the access device having the serial number from playing the encrypted data, in which in the encrypting step the data is an electronic book and the ***access device is a personal digital assistant (PDA) or mobile phone*** having an electronic book playing function for playing the contents of the electronic book.

The primary reference to Howard et al. teaches a limited-use browser and security system including connecting a computer (121, 125, 135, 137) to a web server (109). It is important to note that Howard et al. fail to teach anything about mobile network access devices at all, much less sending and receiving encrypted data to a PDA or mobile phone.

Howard et al. do not teach a method for safely encrypting transmission data including the step of preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is an music data and the access device is a personal digital assistant (PDA) or mobile phone having an MP3 playing function for playing the music data. Nor do Howard et al. teach a method for safely encrypting transmission data including the step of preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is an electronic book and the access device is a personal digital assistant (PDA) or mobile phone having an electronic book playing function for playing the contents of the electronic book.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Howard et al. do not disclose each and every feature of Applicant's amended claims

and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Howard et al. cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

The secondary reference to Candelore teaches a method and apparatus for securing control words and is cited for teaching downloadable audio-visual files, such as MP3-formatted audio files.

Candelore does not teach a method for safely encrypting transmission data including the step of preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is an music data and the access device is a personal digital assistant (PDA) or mobile phone having an MP3 playing function for playing the music data. Nor does Candelore teach a method for safely encrypting transmission data including the step of preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is an electronic book and the access device is a personal digital assistant (PDA) or mobile phone having an electronic book playing function for playing the contents of the electronic book.

Even if the teachings of Howard et al. and Candelore were combined, as suggested by the Examiner, the resultant combination does not suggest: a method for safely encrypting transmission data including the step of preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is an music data and the access device is a personal digital assistant (PDA) or mobile phone having an MP3 playing function for playing the music data. Nor does the resultant combination teach a method for safely encrypting transmission data including the step of preventing users not connected to the access device having a serial number from playing the encrypted data, in which in the encrypting step the data is an electronic book and the access device is a personal digital assistant (PDA) or mobile phone having an electronic book playing function for playing the contents of the electronic book.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which

allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Howard et al. or Candelore that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Howard et al. nor Candelore disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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